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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,440	08/26/2003	Kil-soo Jung	1793.1004	1637
49455	7590	05/18/2007		
STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			EXAMINER CHIO, TAT CHI	
			ART UNIT 2621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/647,440	Applicant(s) JUNG ET AL.	
	Examiner Tat Chi Chio	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/11/2004 and 2/24/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/647443. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application direct to the same invention as the conflicting claims of the copending application. The instant application claims an apparatus and a playback device, and the copending application claims the methods of using the apparatus and playback device in the instant application.

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Consider claims 1-7, an apparatus to reproduce AV data in an interactive mode, the apparatus comprising: an AV playback engine that plays back the AV data; and an ENAV engine that interprets and executes a markup document; wherein, when a key input event corresponding to a user action occurs, the ENAV engine informs, by default, the AV playback engine of the occurrence of the key input event.

Claims 1-7 of the instant application is conflicting with the claims 1-7 of the copending application, which directs to the method of using claims 1-7 of the instant application. The claims depending on the claim 1 of the instant application is also affected.

Consider claims 8-13, a playback device, comprising: a reader to read AV data; an ENAV engine, coupled to the reader, a blender and an AV playback engine, the ENAV engine outputting a key input event signal to the AV playback engine in accordance with user input, receiving a trigger signal from the AV playback engine, sending a control signal to the AV playback engine, and receiving a markup document, verifying, interpreting, executing and sending an interpreted markup document to the blender in accordance with the trigger signal; the AV playback engine, coupled to the ENAV engine, the blender and the reader, to, upon receiving the key input event signal from the ENAV engine and determining a point in time required to trigger the markup document, send the trigger signal to the ENAV engine, and control play back of DVD-Video data in accordance with the key input event signal from the ENAV engine; and the blender, coupled to the ENAV engine and the AV playback engine, to blend and

output a DVD-Video stream that has been played back with the interpreted markup document.

Claims 8-13 of the instant application is conflicting with the claims 8-11 of the copending application, which directs to the method of using claims 8-13 of the instant application. The claims depending on the claim 8 of the instant application is also affected.

Therefore, it is obvious to one of ordinary skill in the art to use the apparatus and playback device of the instant application with the methods of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/647445. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application direct to the same invention as the conflicting claims of the copending application. The instant application claims an apparatus and a playback device, and the copending application claims the information storage medium played by the apparatus and playback device in the instant application.

Consider claims 1-7, an apparatus to reproduce AV data in an interactive mode, the apparatus comprising: an AV playback engine that plays back the AV data; and an ENAV engine that interprets and executes a markup document;

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wherein, when a key input event corresponding to a user action occurs, the ENAV engine informs, by default, the AV playback engine of the occurrence of the key input event.

Claims 1-7 of the instant application is conflicting with the claims 1-11 of the copending application, which directs to the information storage medium played by the claims 1-7 of the instant application. The claims depending on the claim 1 of the instant application is also affected.

Consider claims 8-13, a playback device, comprising: a reader to read AV data; an ENAV engine, coupled to the reader, a blender and an AV playback engine, the ENAV engine outputting a key input event signal to the AV playback engine in accordance with user input, receiving a trigger signal from the AV playback engine, sending a control signal to the AV playback engine, and receiving a markup document, verifying, interpreting, executing and sending an interpreted markup document to the blender in accordance with the trigger signal; the AV playback engine, coupled to the ENAV engine, the blender and the reader, to, upon receiving the key input event signal from the ENAV engine and determining a point in time required to trigger the markup document, send the trigger signal to the ENAV engine, and control play back of DVD-Video data in accordance with the key input event signal from the ENAV engine; and the blender, coupled to the ENAV engine and the AV playback engine, to blend and output a DVD-Video stream that has been played back with the interpreted markup document.

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Claims 8-13 of the instant application is conflicting with the claims 1-11 of the copending application, which directs to the information storage medium played by the claims 8-13 of the instant application. The claims depending on the claim 8 of the instant application is also affected.

Therefore, it is obvious to one of ordinary skill in the art to use the apparatus and playback device of the instant application to play the information storage medium of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Lamkin et al. (US 7,178,106 B2).

Consider claim 1, Lamkin et al. teach an apparatus to reproduce AV data in an interactive mode, the apparatus comprising:

- an AV playback engine that plays back the AV data (422, 426 and 734 of Fig. 7);
- an ENAV engine that interprets and executes a markup document (742, 410, 702, 704, 706, 708, 701, 712, 714, and 716 of Fig. 7);
wherein, when a key input event corresponding to a user action occurs, the ENAV engine informs, by default, the AV playback engine of the occurrence of the key input event.

Consider claim 2, Lamkin et al. teach the apparatus, wherein the ENAV engine allows the key input event to occur using first event information written in the markup document (col. 19, lines 44-47).

Consider claim 3, Lamkin et al. teach the apparatus, wherein the ENAV engine generates an API command to control the AV playback engine, in response to the key input event corresponding to the user action (col. 11, lines 56-66).

Consider claim 4, Lamkin et al. teach the apparatus, wherein, when a second event occurs using second event information recorded in the markup document, the ENAV engine refrains from informing the AV playback engine of the occurrence of the key input event (col. 19, lines 51-53).

Consider claim 5, Lamkin et al. teach the apparatus, wherein, when the key input event occurs using the first event information, the ENAV engine transmits a playback control command corresponding to the key input event to the AV playback engine to handle the key input event (col. 11, lines 54-67 and col. 12, lines 1-15).

Consider claim 6, Lamkin et al. teach the apparatus, wherein when an onclick event occurs using the first event information, the ENAV engine transmits a playback control command corresponding to the onclick event to the AV playback engine to handle the onclick event (col. 19, lines 44-47).

Consider claim 7, Lamkin et al. teach the apparatus, wherein the ENAV engine comprises an interface handler that informs the AV playback engine of the occurrence of the key input event (702 of Fig. 7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamkin et al. (US 7,178,106 B2) in view of Kanazawa et al. (US 6,580,870 B1).

Consider claim 8, Lamkin et al. teach a playback device, comprising: a reader to read AV data (736 of Fig. 7); an ENAV engine, coupled to the reader, a blender and an AV playback engine, the ENAV engine outputting a key input event signal to the AV playback engine in accordance with user input, receiving a trigger signal from the AV playback engine, sending a control signal to the AV playback engine, and receiving a markup document, verifying, interpreting,

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executing and sending an interpreted markup document to the blender in accordance with the trigger signal (742, 410, 702, 704, 706, 708, 701, 712, 714, and 716 of Fig. 7); the AV playback engine, coupled to the ENAV engine, the blender and the reader, to, upon receiving the key input event signal from the ENAV engine and determining a point in time required to trigger the markup document, send the trigger signal to the ENAV engine, and control play back of DVD-Video data in accordance with the key input event signal from the ENAV engine (422, 426 and 734 of Fig. 7); but fail to teach the blender, coupled to the ENAV engine and the AV playback engine, to blend and output a DVD-Video stream that has been played back with the interpreted markup document.

Kanazawa et al. teach the blender, coupled to the ENAV engine and the AV playback engine, to blend and output a DVD-Video stream that has been played back with the interpreted markup document (113 of Fig. 16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a blender into the system to display the video and HTML page together on the monitor.

Consider claim 9, Lamkin et al. teach the playback device, wherein the AV data includes DVD-Video data and a markup document (col. 5, lines 55-57).

Consider claim 10, Lamkin et al. teach the playback device, wherein the playback device operates in one of: an interactive mode, a video mode, and a full-screen mode that is a sub-display of the interactive mode (col. 19, lines 41-44).

Consider claim 11, Kanazawa et al. further teach the playback device, wherein the playback device fetches a markup document from a network (100 of Fig. 16).

Consider claim 12, Lamkin et al. teach the playback device, wherein one of: when a first event information is recorded in the markup document and a first event occurs using the first event information, the ENAV engine informs the AV playback engine of the occurrence of the first event (col. 19, lines 44-47); when a key input event corresponding to a user action occurs, the ENAV engine informs, by default, the AV playback engine of the occurrence of the key input event (col. 19, lines 44-47); when second event information is recorded in the markup document and a second event occurs using the second event information, the ENAV engine prohibits the AV playback engine from being informed of the occurrence of the key input event corresponding to user action of the second event (col. 19, lines 51-54); and when third event information is recorded in the markup document and a third event occurs using the third event information when the user input is forwarded directly to or prohibited from being forwarded to the AV playback engine, the ENAV engine performs an operation corresponding to the third event (col. 19, lines 58-59).

Consider claim 13, Lamkin et al. teach the playback device, wherein the ENAV engine comprises: a parser and interpreter (612 of Fig. 6); an interface handler (614 of Fig. 6), coupled to receive user input, to the parser and interpreter, to the AV playback engine, and to a decoder; and the decoder (626 of Fig. 6), coupled to the parser and interpreter and to the interface handler.

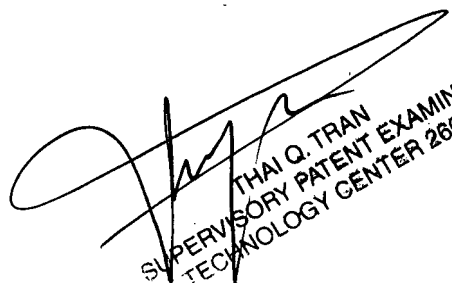
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tat Chi Chio whose telephone number is (571) 272-9563. The examiner can normally be reached on Monday - Thursday 8:30 AM-6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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